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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/627,232 | 07/27/2000 | Nancy George | 066990.0102 | 2324 |

7590 01/13/2005
Baker Botts LLP
The Warner
1299 Pennsylvania Avenue N W
Washington, DC 20004-2400

EXAMINER

KINDRED, ALFORD W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2163

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Applicati n No. | Applicant(s) | |
| | 09/627,232 | GEORGE, NANCY | |
| | Examin r | Art Unit | |
| | Alford W. Kindred | 2163 | |

-- The MAILING DATE f this communication appears n th cover sheet with the correspondence address --

Peri d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication: Response, filed on 07/28/04.

This action is made final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al., US# 6,138,199, in view of Lederer, JR. et al., US# 2002/0023109 A1.

As per claims 1-2, Hall et al. teaches "editing said gathered compliance data to include organizational data and formatting a portion of said compliance data to create modified compliance data" (see col. 5, lines 32-54, whereas Hall's "rights management" reads applicant's "compliance data") "storing said modified compliance data within data . . . classification scheme relating to compliance data . . ." (see col. 7, lines 4-40) "transferring said modified compliance data from said database . . ." (see col. 18, lines 16-44). Hall et al. does not teach "said compliance data comprising at least one requirement for complying with at least one of standards, regulations and laws." Lederer et al. teaches "said compliance data comprising at least one requirement for complying with at least one of

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standards, regulations and laws” (see page 3, lines [0041]-[0042]). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Lederer and Hall, because using the steps of “said compliance data comprising at least one requirement for complying with at least one of standards, regulations and laws” would have given those skilled in the art the tools to set specific standards for the use in describing data that must abide by data rules. This give users the advantage of maintaining the integrity level of transferred data in a network environment more efficiently.

As per claims 3-5, Hall et al. teaches “compliance data . . . user’s preference . . .” (see col. 16-54).

As per claim 6, Hall et al. teaches “monitors user traffic . . .” (see col. 9, lines 39-64).

As per claim 7, Hall et al. teaches “displaying said modified compliance data . . .” (see col. 7, lines 5-24).

As per claim 8, Hall et al. teaches “Government standards . . .” (see col. 4, lines 47-58).

As per claims 9-11, Hall et al. teaches “wherein said database is publicly inaccessible and password . . .” (see col. 4, lines 57-67).

As per claim 12, Hall et al. teaches “uploading compliance data from a remote communication device” (see col. 18, lines 10-43).

As per claims 13-19, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 1-12 and are similarly rejected.

Response to Arguments

4. Applicant's arguments filed 7/28/04 have been fully considered but they are not persuasive.

--As per applicant's arguments regarding "the office action asserts that 'Hall's rights management reads on applicant's compliance data . . . this is simply incorrect . . .", examiner maintains that Hall's "right management" includes the regulation of data via the governing of access to data, which is implied by applicant's claim language reference to "compliance data". Therefore the teachings are substantially similar. Further, applicant asserts that compliance data is content and therefore is different from Hall's "rights management". Examiner disagrees since both Hall's "rights management" and applicant's "compliance data" have variables and contain data/content, they are illustrative of the governing of data in general and therefore Hall's teachings read on applicant's claim language (i.e. compliance data).

--As per applicant's arguments regarding that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the Lederer which clearly describe rules that data must abide by which in the same realm as applicant's claim of compliance data.

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One of ordinary skill in the art would have recognized the motivation to combined the Lederer and Hall references with the implication that both references together better teach the rules and regulations that data must abide by as indicated in applicant's claim language.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 571-272-4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alford W. Kindred', is written over the printed name.

Alford W. Kindred
Patent Examiner
Tech Ctr. 2100